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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,586	09/18/2000	Glenn Adler	US000231	4088

7590

04/04/2003

Corporate Patent Counsel  
US Philips Corporation  
580 White Plains Road  
Tarrytown, NY 10591

EXAMINER

BECKER, SHAWN M

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 04/04/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/663,586

Applicant(s)

ADLER, GLENN

Examiner

Shawn M. Becker

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to a stand-alone monitor with storage media and a user interface, classified in class 345, subclass 700.
  - II. Claims 11-19, drawn to a stand-alone monitor with a wireless communication port, classified in class 345, subclass 718.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Group I makes no mention of wireless communication, and is instead directed toward the storage techniques of using an image buffer and different types of storage media types. Group I is also directed toward a user interface for performing manipulations on the images, which is not described in Group II. Instead, Group II is directed toward the wireless communication between a source and a monitor. Therefore, the invention of Group II could be performed on an entirely different monitor than that of Group I.
3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Art Unit: 2173

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Michael Schmidt on 3/20/03 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the interface referred to in claim 3 is the basic interface for the monitor or the user-interface for controlling the digital images.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 2173

8. Claims 1-9 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by the Sony CyberFrame PHD-A55 (hereinafter CyberFrame) as supported by the product review in TechTV (hereinafter TechTV) and the product description in Outpost.com (hereinafter Outpost).

Referring to claim 1, the CyberFrame is a stand-alone monitor having an interface with a storage medium reader that reads a digital image stored on a storage medium. See the second paragraph in TechTV that describes how memory sticks (storage medium) are read to display images from a digital camera. There inherently has to be a controller to process and transfer the image from the memory stick to be displayed in the display screen of the CyberFrame. The third paragraph in TechTV describes a user-interface operable to enable issuing a command to the controller to control the reading and display of the digital images on the display screen. See how the user can navigate through the images, rotate the images, and set up a slide show.

Referring to claim 2, the CyberFrame inherently has to have an image buffer in order to perform the slide show capabilities as described in the fourth feature of Outpost. The images selected by the user to be displayed in intervals are read by the memory stick reader (storage medium reader) and transferred to an image buffer for storage and display on the display screen.

Referring to claim 3, the controller of the CyberFrame is also used to perform a task, unrelated to the interface. See in the Specifications of Outpost, how there is a date and time display and a clock set, which must be performed by a controller.

Referring to claim 4, the controller of the CyberFrame processes the read digital image into a format that is compatible with the signal input of the display. See the JPEG playback in the first listed Feature in Outpost.

Art Unit: 2173

Referring to claims 5-6, the CyberFrame's user-interface enables the user to manipulate the image displayed, such as deleting or protecting images (stored data), sequencing the display of multiple images (slide show), resizing and rotating images. See the third paragraph of TechTV and the fourth, sixth, and seventh Features in Outpost.

Referring to claim 7, the manipulations are performed via on-screen menu selection through the user-interface. One of the Specifications in Outpost is an on-screen menu.

Referring to claim 8, the display screen is an LCD. See the second Feature in Outpost.

Referring to claim 9, the storage medium is a memory stick. See the first paragraph in Outpost.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over CyberFrame and the article entitled "Sony's \$900 Picture Frame", by Mark Gimein.

The storage medium reader of CyberFrame is only capable of reading memory sticks. However, as Gimein points out other types of storage medium (formats) do a good job of storing digital images and other data. See the third paragraph on page 2. It would have been obvious to one of ordinary skill in the art to modify the storage medium reader of CyberFrame to be able to read two or more different storage media types to make the CyberFrame compatible with other vendor's storage technology as supported by Gimein.

Art Unit: 2173

*Conclusion*

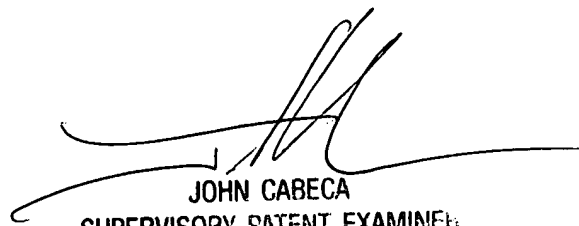
11. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach stand-alone displays for digital images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-T 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-305-3116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-745-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

smb  
March 21, 2003



JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100